

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Louis R. Jackson, Jr.

Confirmation No.:

Application No.: 09/832,387

Examiner: Vortman, A.

Filing Date: 04/11/2001

Group Art Unit: 2835

Title: FLAT HANGING COMPUTER

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith in **triplicate** is the Appeal Brief in this application with respect to the Notice of Appeal filed on 01/28/2004.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$330.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

() one month	\$110.00
() two months	\$420.00
() three months	\$950.00
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() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of \$330.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

Louis R. Jackson, Jr.

By [Signature]

Manish B. Vyas

Attorney/Agent for Applicant(s)

Reg. No. **54,516**

Date: **March 26, 2004**

Telephone No.: **(281) 970-4545**



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Louis R. Jackson, Jr.

Serial No.: 09/832,387

Filed: April 11, 2001

For: FLAT HANGING COMPUTER

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Group Art Unit: 2835

Examiner: Forman, A.

Atty Docket: COMP:0205/FLE/SWA/VYA
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Manish Vyas

Dear Sir:

APPEAL BRIEF PURSUANT TO 37 C.F.R. §§ 1.191 AND 1.192

Appellant files this Appeal Brief, in triplicate, in furtherance of the Notice of Appeal transmitted by First Class Mail to the U.S. Patent and Trademark Office on January 28, 2004, and received by the U.S. Patent and Trademark Office on February 2, 2004.

1. **REAL PARTY IN INTEREST**

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the state of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly owned affiliate of Hewlett-Packard Company, a Delaware corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

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2. **RELATED APPEALS AND INTERFERENCES**

Appellant is unaware of any other appeals or interferences related to this Appeal. The undersigned is Appellant's legal representative in this Appeal.

3. **STATUS OF CLAIMS**

Claims 1-50 are currently pending, and claims 1-50 are currently under final rejection and, thus, are the subject of this Appeal.

4. **STATUS OF AMENDMENTS**

All amendments to the claims of the present application have been entered, and Appellant has not submitted any amendments subsequent to the Final Office Action mailed on November 4, 2003.

5. **SUMMARY OF THE INVENTION AND OF THE DISCLOSED EMBODIMENTS**

The present invention is associated with space-saving techniques for computer systems. *See* Application, p. 2, ll. 16-17. As one example, the present invention provides a flat panel computer 12 communicatively coupled to a keyboard 14 via a cable 16. *See id.*, p. 5, ll. 1-4; Fig. 1. The flat panel computer includes an enclosure 18 housing a display 20 in a plurality of internal computer components. *See id.*, p. 5, ll. 4-5. By way of example, the internal computer components include a processor, data storage devices (*e.g.*, a disk drive, random access memory (RAM), a hard drive, etc.), a mother board, a battery, software (*e.g.*, operating systems, applications, etc.), and other desired devices. *See id.*, p. 5, ll. 14-17. All of the foregoing components, in the exemplary embodiment, are disposed within the enclosure 18 and configured to form a personal computer. *See id.* For example, the exemplary flat panel computer 12 includes an operating system for receiving user instructions.

To conserve work space, the exemplary flat panel computer 12 includes mounting structures for vertical orientation of the enclosure 18. *See* Application, p. 13, ll. 15-16. By way of example, the exemplary flat panel computer 12 includes wall mounts 208 and 210 disposed along an upper portion 212 of the flat panel computer 12. *See id.*, p. 13, ll. 17-18; Fig. 6. The exemplary wall mounts 208 and 210 comprise mounting slots having narrow portions 214 and 216 extending into enlarged portions 218 and 220, respectively. *See id.*, p. 13, ll. 18-20.

Accordingly, the wall mounts 208 and 210 provide a mechanism through which the flat panel computer 12 mounts to various fasteners or mounting members (*e.g.*, nails, screws, etc.) coupled to a vertical surface, *e.g.*, a wall. *See id.*, p. 13, l. 20-p. 14, l. 2. Advantageously, such wall mounts provide a personal computer that is operable without consuming an inordinate amount of horizontal work space. *See id.*, p. 4, ll. 13-17.

6. **ISSUES**

Issue No. 1

Whether the Wehr reference (German Patent No. De/29,616,175) anticipates claims 1-18, 20-32, 34-42, and 44-50 under 35 U.S.C. § 102(b).

Issue No. 2

Whether dependent claims 19, 33, and 43 are unpatentable under 35 U.S.C. § 103(a) as obvious in view of the Wehr reference and in further view of the Lochridge reference (U.S. Patent No. 5,610,798).

Issue No. 3

Whether claims 1-50 are unpatentable under 35 U.S.C. § 103(a) as obvious in view of the Goodrich et al. reference (U.S. Patent No. 5,375,076) and in further view of the Wehr reference.

Issue No. 4

Whether dependent claims 19, 33, and 43 are unpatentable under 35 U.S.C. § 103(a) as obvious in view of the Goodrich et al. reference and in further view of the Wehr reference and the Lochridge reference.

7. **GROUPING OF CLAIMS**

Claim 1-50 stand or fall together.

8. **ARGUMENTS**

Issue No. 1

In the Final Office Action, the Examiner rejected claims 1-18, 20-32, 34-42, and 44-50 under 35 U.S.C. § 102(b) as anticipated by the Wehr reference. Appellant respectfully traverses the rejection and requests that the Board withdraw any outstanding rejections in relation to the instant claims. In summary, Appellant respectfully asserts that the Wehr reference fails to disclose all of the features recited in the instant claims.

First, Applicants remind the Examiner that, during patent examination, the pending claims must be given an interpretation that is reasonable and consistent with the specification. *See In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); *see also In re Morris*, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); *see also* M.P.E.P. §§ 608.01(o) and 2111. Interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *See In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); *see also* M.P.E.P. § 2111. As further explained in Section 2111.01 of the M.P.E.P., the words of the claim must be given their plain meaning unless the applicant has provided a clear definition in the specification. *See In re Zletz*, 893 F.2d 319, 321, 13 U.S.P.Q.2d 1320, 1322 (Fed. Cir. 1989). Again, the plain meaning refers to an interpretation by those of ordinary skill in the art. *See In re Sneed*, 710 F.2d 1544, 218 U.S.P.Q. 385 (Fed. Cir. 1983).

Secondly, anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Indeed, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

However, prior to addressing the specifics of the instant claims, Appellant addresses the Examiner’s assertions regarding the definition of “personal computer” as recited in the instant claims. In the Final Office Action, the Examiner provided a definition for the recitation

“personal computer.” *See* Final Office Action dated November 4, 2003, p. 7. Specifically, the Examiner cited IEEE 100 The Authoritative Dictionary of IEEE Standard Terms, which states:

personal computer (1) A system, containing a host and a limited number of peripherals designed *to be used in the home or in small offices*, that *enables individuals to perform a variety of computing or word-processing functions or both . . .*

(2) A single-user microcomputer *designed for personally controllable applications*.

See Final Office Action Mailed November 4, 2003; *see also* IEEE 100 The Authoritative Dictionary of IEEE Standard Terms 812 (7th Ed.) (emphasis added). However, in the Advisory Action dated January 26, 2004, the Examiner stated that “the Examiner had ONLY relied on the definition that the personal computer is ‘a single-user microcomputer designed for personally controllable [sic] applications’.” *See* Advisory Action dated January 26, 2004, p. 2 (emphasis in original).

Although the Examiner has provided a definition, the definition must still be consistent with the specification. As discussed above, during patent examination the pending claims must be an interpretation that is reasonable and consistent with the specification. *See In re Hyatt*, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000). Additionally, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *See In re Cortright*, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999). With the foregoing precedent in mind, Appellant respectfully asserts that the Wehr reference fails to disclose a personal computer as recited in the instant claims and as defined by the Examiner. That is, even if the Examiner’s definition of a personal computer is accepted, the Wehr reference still fails to disclose a personal computer.

Independent Claims 1, 21, 37, and 46, and the Claims Depending Therefrom.

Each of the rejected independent claims (*i.e.*, claims 1, 21, 37, and 46) recites a personal computer. Specifically, the independent claims respectively recite:

Claim 1: “a *personal computer* including a housing configured for a display, the housing having a plurality of computing components disposed therein;”

Claim 21: “a *personal computer* . . . [having] a housing comprising a display;”

Claim 37: “a *personal computer* having a computer enclosure;”
and

Claim 46: “integrating a display assembly with a plurality of computing components in a panel enclosure of a *personal computer*.”

(Emphasis added).

The Wehr reference fails to disclose any semblance of a *personal computer*. Rather, the translation of the Wehr reference, as provided by the Examiner, states that “*in contrast to the current-notebook computers*, with which the main emphasis points are the production, change, calculation and the managing of data, the device according to the invention should serve *solely for the reproduction of data systems*.” Translation of the Wehr reference, p. 3, ll. 3-7 (emphasis added). The electronic display device of the Wehr reference requires the use of an *independent computer system* to input data into and control the electronic display device. *See id.*, p. 1, ll. 9-13. Thus, the display device of the Wehr reference is *incapable* of receiving input controls from a user. Rather, the electronic display device of the Wehr reference presents nothing more than “an advertising means or . . . an item of furniture (‘electronic wall picture’).” *See id.*, p. 1.

With the foregoing in mind, Appellant respectfully asserts that the electronic display device of the Wehr reference fails to meet the definition of a personal computer, even as provided by the Examiner. For example, the *limited* purpose of providing only a display device, as taught by the Wehr reference, is in stark contrast to a personal computer that “is a single-user microcomputer designed for personally controllable applications,” as defined by the Examiner. *See* Final Office Action dated November 4, 2003; IEEE 100 The Authoritative Dictionary of IEEE Standard Terms 812 (7th ed.). For example, the electronic display device of the Wehr reference requires a separate computer to perform any semblance of operation or control. *See* Translation of the Wehr Reference, p. 1, ll. 9-13. Accordingly, the electronic display device of Wehr is not *personally controllable* and, as such, is not designed for *personally controllable applications*. Indeed, as quoted above, the Wehr reference explicitly states that the disclosed electronic display device is “*in contrast to the current-notebook computer*” and “should serve

solely for the reproduction of data systems.” See Translation of the Wehr reference, p. 3, ll. 3-7 (emphasis added). In contrast to the Examiner’s assertion, the Wehr reference does not disclose “a personal computer SPECIFICALLY ADAPTED for use as an electronic display device [sic].” See Advisory Action dated January 26, 2004 (emphasis in original). Rather, the Wehr reference discloses an assembly of electronic components configured to explicitly *not form a personal computer*. See Translation of the Wehr reference, p. 3, ll. 3-7. Although the Wehr reference discloses a device that may include components used in conjunction with a computer, these components are assembled and configured in a manner to *not form a personal computer*. Accordingly, Appellant respectfully asserts that the Wehr reference is absolutely devoid of any semblance of a personal computer, even in view of the Examiner’s definition of a personal computer.

Thus, Appellant respectfully asserts that the Examiner has failed to establish a *prima facie* case of anticipation because the reference cited by the Examiner fails to disclose all of the features recited in the instant claims. Therefore, Appellant respectfully asserts that the Wehr reference fails to anticipate independent claim 1 and its respective dependent claims 2-18 and 20, independent claim 21 and its respective dependent claims 22-32 and 34-36, independent claim 37 and its respective dependent claims 38-42, 44 and 45, and independent claim 46 and its respective dependent claims 47-50. With the foregoing in mind, Appellant respectfully requests that the Board withdraw any outstanding rejections in relation to the instant claims.

Issue No. 2

In the Final Office Action, the Examiner rejected dependent claims 19, 33, and 43 under 35 U.S.C. § 103(a) as obvious in view of the Wehr reference and in further view of the Lochridge reference. Appellant respectfully traverses this rejection and requests that the Board withdraw any outstanding rejections in view of the following remarks. In summary, Appellant respectfully asserts that the Examiner has failed to present a *prima facie* case of obviousness regarding the instant claims, because the Wehr reference and the Lochridge reference, taken alone or in combination, fail to disclose all the features recited in the instant claims.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. at 735. To establish a *prima facie* case, the Examiner

must show that the reference combination includes *all* of the claimed elements and must present a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *See Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

With regard to the instant claims, the Examiner stated that the Wehr reference “disclosed all of the claims [sic] limitations but did not disclose that upright surface (wall) mounting (mount structure (5)) comprises a plurality of keyhole slots.” Final Office Action dated November 4, 2003, p. 3. To satisfy this deficiency, the Examiner relied on the Lochridge reference. *See id.*, p. 3. However, as discussed above, the Wehr reference fails to disclose all of the features recited in the instant claims. For example, the Wehr reference fails to disclose a *personal computer*. Moreover, the Lochridge reference fails to obviate the deficiencies of the Wehr reference as discussed above. Accordingly, Appellant respectfully asserts that the Examiner has failed to present a *prima facie* case of obviousness regarding the instant claims, because the cited reference combination fails to disclose all of the features recited in the instant claims.

Therefore, Appellant respectfully asserts that dependent claims 19, 33, and 43 are patentable not only for their dependencies on allowable base claims, but also for the additional features recited therein. Respectfully, Appellant requests that the Board withdraw any outstanding rejections in relation to the instant claims.

Issue No. 3

In the Final Office Action, the Examiner rejected claims 1-50 under 35 U.S.C. § 103(a) as obvious in view of the Goodrich et al. reference and in further view of the Wehr reference. Appellant respectfully traverses these rejections and requests that the Board withdraw the outstanding rejections in relation to the instant claims in view of the following remarks. In summary, Appellant respectfully asserts that the Examiner has failed to present a *prima facie* case of obviousness regarding the instant claims, because the cited reference combination, at a minimum, lacks the requisite suggestion or motivation for combination.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. at 735. To establish a *prima facie* case, the Examiner must show that the reference combination includes *all* of the claimed elements and must present a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *See Ex parte Clapp*, 227 U.S.P.Q. at 972. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. at 933. Indeed, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir 1988). In other words, the artisan, viewing only the collective teachings of the references, must find it obvious to selectively pick and choose various elements and/or concepts from the cited references to arrive at the claimed invention. *See Ex parte Clapp*, 227 U.S.P.Q. at 972. Moreover, the Federal Circuit has warned that the Examiner must not, “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)). Avoiding hindsight reconstruction is especially important regarding less technologically complex inventions, where the very ease with which the invention can be understood may prompt one employ such hindsight. *See id.*

The Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *See In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Additionally, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959). Thus, it is improper to combine references where the references *teach away* from their combination. See *In re Grasselli*, 218 U.S.P.Q. 769,779 (Fed. Cir. 1983). With the foregoing in mind, Appellant respectfully demonstrates below that the instant claims are not obvious in view of the Examiner's cited references.

Independent Claims 1, 21, 37, 46 and the Claims Depending Therefrom

In the pending claims, each independent claims recites, in various forms and permutations, a personal computer that is configured for wall mounting. Specifically, the pending independent claims recite:

Claim 1: “a *personal computer* including a housing configured for a display . . . and a *wall mount* structure configured to mount the housing on a substantially *vertical surface*;”

Claim 21: “a *personal computer* comprising . . . a housing comprising a display . . . and an *upright surface mount* configured to mount the housing to a substantially *upright surface*;”

Claim 37: “a *personal computer* having a computer enclosure . . . and a *surface mount* configured to mount the computer enclosure to a *wall*;” and

Claim 46: “integrating a display assembly with a plurality of computing components in a panel enclosure of a *personal computer* . . . and coupling a *vertical surface mount* to the panel enclosure.”

(Emphasis added).

With regard to the above-quoted claim recitations, the Examiner concedes that the Goodrich reference fails to disclose “a mount structure configured to mount the housing on a substantially vertical surface (wall).” See Final Office Action dated November 4, 2003, pp. 3-4. However, to cure this deficiency, the Examiner presented the Wehr reference and stated that the

Wehr reference “disclosed a hangable computer (Figs. 1-4) including display (1), the computer display having a mount structure (5) configured to mount said display on a vertical surface (wall) in order to save [sic] the working surface space.” *See* Final Office Action dated November 4, 2003, p. 4. Moreover, the Examiner stated “[s]ince the inventions of Goodrich and of DE/29,616,175 [the Wehr reference] are from the same field of endeavor (computer displays), the purpose of the mount structure configured to mount said display on a vertical surface as taught by [the Wehr reference] would be recognized in the invention of Goodrich.” *See id.* Accordingly, the Examiner concluded that “[i]t would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to supplement said display of Goodrich with the mount structure as taught by [the Wehr reference] in order to facilitate mounting of the display of Goodrich on the vertical surface in order to save [sic] the space on a working surface.” *See id.* Appellant respectfully disagrees with the Examiner’s interpretation of the Goodrich and Wehr references.

As discussed above, the Wehr reference merely discloses a display device, and not a *personal computer* as recited in each of the above-listed independent claims and as defined by the Examiner. Again, the Wehr reference merely discloses an electronic display device that serves a *single* function: displaying data provided by an independent computer system. *See* Translation of the Wehr reference, p. 1. Indeed, the Wehr reference explicitly states that the disclosed electronic display device is “*in contrast* to current-notebook computers.” *See id.*, p. 3, l. 3. Moreover, the device of Wehr requires an independent computer for control and input functions. *See id.*, p. 4. Accordingly, the Wehr reference fails to disclose a device that is *personally controllable*, let alone a personal computer as defined by the Examiner: “a single-user microcomputer designed for personally controllable applications.” *See* IEEE 100 The Authoritative Dictionary of IEEE Standard Terms 812 (7th ed.). Thus, in contrast to the Examiner’s assertion, the Wehr reference fails to disclose a personal computer.

Additionally, the Goodrich reference teaches away from combination with the Wehr reference. The Goodrich reference discloses a “*portable* computer system that functions as a *notepad* computer and includes provisions for receiving and storing a keyboard to operate as a *notebook* computer.” Goodrich, col. 1, ll. 7-11 (emphasis added). Thus, the primary thrust of the Goodrich reference is the *portability* of the notepad computer disclosed therein. This *portability*

is wholly antithetical to the wall-mounted display device disclosed by the Wehr reference. More specifically, mounting the Goodrich notebook computer to a wall wholly vitiates the *portable* nature of the notebook computer system of Goodrich. Again, Appellant notes that if a proposed modification or combination of the prior art changes the principle of operation of the prior art invention being modified, then the teaching of the references is not sufficient to render the claims *prima facie* obvious. See *In re Ratti*, 123 U.S.P.Q. at 349. Clearly, in the instant case, mounting a *portable* computer to a wall changes the portable principle of operation of a notebook or portable computer. A mounted computer is no longer portable. In addition, wall-mounting would render the portable computer of Goodrich et al. inoperable for its intended purpose: user interaction in a portable or mobile manner. Indeed, the Examiner has failed to present a cogent as to why a skilled artisan would find the motivation to mount the *portable* notebook computer of the Goodrich reference to a wall. With the foregoing in mind, Appellant respectfully asserts that the Goodrich reference *teaches away* from the modification proposed by the Examiner, because the Goodrich reference touts the advantages of a *portable notepad* computer, which is antithetic to a *wall-mounted* device.

Thus, Appellant respectfully asserts that the Examiner has failed to establish a *prima facie* case of obviousness, because the Examiner's proposed combination or modification would change the principle of operation of the Goodrich and Wehr references. Therefore, independent claims 1, 21, 37, 46 and their respective dependent claims 2-20, 22-35, 38-45, and 47-50 are patentable over the cited references, taken alone or in combination. With the foregoing in mind, Appellant respectfully requests that the Board withdraw any outstanding rejections in relation to the instant claims.

Patentable Weight of Functional Language

Prior to concluding this issue, Appellant addresses the Examiner's interpretation of claim construction below. In the Final Office Action, more particularly in reference to the rejection of dependent claims 35 and 40 under the Weir-Goodrich reference combination, the Examiner stated:

Regarding the functional recitation "wall mountable", please note that it is narrative in form, since any thing [sic] can be mounted to the wall. In order to be given a proper patentable weight, a functional recitation must be expressed as a "means" for performing the specified function (i.e. a specific structure which would allow the device to be readily mounted to the wall), as set forth in 35 USC

§ 112, 6th paragraph, or must be supported by recitation in the claims of sufficient structure to warrant the presence of functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Office Action Mailed November 4, 2003, p. 6 (emphasis in original). Appellant disagrees with the Examiner's interpretation of long-standing precedent and black-letter law. With that in mind, Appellant respectfully disagrees with the Examiner's failure to give functional weight to the recitation "wall-mountable" as recited in claims 35 and 45.

The rules of claim interpretation suggested by the Examiner are incorrect for several reasons. First, the functional language recited in the claims are to be given patentable weight. Secondly, to be given patentable weight, a functional recitation *does not* have to be expressed as a "means" for performing the specified function. Thirdly, a functional limitation *does not* have to "be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language."

First, the Examiner's assertion that "wall mountable" is a functional recitation and, as such, is not given patentable weight because it is "narrative in form" was improper. Appellant respectfully asserts that the Examiner has failed to define "narrative in form" and has also failed to provide the *legal basis* for not giving the allegedly functional limitation patentable weight because of such "narrative" status.

Although the Examiner cited the *In re Fuller* decision (a case decided in 1929), a review of this case fails to show support for the Examiner's position. The *In re Fuller* case revolved around an invention that "consists of a *process* for constructing a woolen fabric for clothing which will have all the advantages of the ordinary woolen fabric yet will not become unduly shiny or glossy as a result of friction and wear." *In re Fuller*, 35 F.2d 62 (C.C.P.A. 1929) (emphasis added). The focus of the court in *In re Fuller* was the lack of *written description* and a failure to adequately support the claimed invention, which related to a *process*. The only statement Appellant found in this case regarding functional language is a cursory statement that "[i]t [the rejected claim] is also *functional*, describing a result only, and not a *process*, and can, therefore, have no standing here." *Id.* (emphasis added). In view of the foregoing passage, the *In re Fuller* case appears to be limited to process claims describing a result and, as such, the case does not provide legal basis for ignoring the recitation of "wall mountable," as set forth in the

instant claims. Moreover, the *In re Fuller* case does not require that functional language necessarily invokes 35 U.S.C. § 112, sixth paragraph. Indeed, *In re Fuller* case was decided almost twenty four years prior to the enactment of Section 112.

The only other support the Examiner provided for his assertion regarding the patentable weight of “wall mountable” was his statement that “it [the claim recitation] is narrative in form, since any thing [sic] can be mounted to the wall.” Appellant respectfully asserts that such an interpretation is unreasonable and contrary to what one of ordinary skill in the art would believe. *Cf.* M.P.E.P. § 2173.05(g) (stating that “a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used”). Clearly, the term wall mountable in combination with the specific structures recited in the instant claims would fairly convey wall-mounting mechanisms for the respective structures. Accordingly, the recitation “wall mountable” should undoubtedly be given patentable weight.

Secondly, to be given patentable weight, a functional recitation *does not* have to be expressed as a “means” for performing the specified function, particularly where the claims are not intended to fall within the scope of 35 U.S.C § 112, sixth paragraph. The instant claims are not intended to be “means for” claims and, as such, Section 112, sixth paragraph, is inapplicable to the instant claims. Indeed, the Examiner’s citation to the *Donaldson* case, a case related to the interpretation of means-plus-function claims, is inapplicable to the instant claims, which are not means-plus-function claims.

Thirdly, a functional limitation *does not* have to “be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language,” as asserted by the Examiner. The M.P.E.P. § 2173.05(g) specifically states that:

There is *nothing inherently wrong* with defining some part of an invention in *functional terms* . . . A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used . . . A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is recited by the element, ingredient or step.

M.P.E.P. § 2173.05(g) (citing *In re Swinehart*, 439 F.2d 210, 213, 169 U.S.P.Q. 226, 228-29 (C.C.P.A. 1971) (emphasis added). Indeed, courts have recognized that there may be a practical *necessity* for the use of functional language. See *In re Swinehart*, 439 F.2d 210, 213, 169 U.S.P.Q. 226, 228-29 (C.C.P.A. 1971) (emphasis added). Under the view today, functional language in a claim is not objectionable *per se* so long as it avoids problems of undue breadth and vagueness. See Donald S. Chisim, CHISIM ON PATENTS § 8.04, p. 8-99 (citing *In re Swinehart*, 169 U.S.P.Q. at 226). What is important is *not* simply that a recitation is defined in terms of what it does, but that the recitation has a reasonably well-understood meaning in the art. *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 U.S.P.Q.2d 1783, 1786 (Fed. Cir. 1996) (further stating that “many devices take their names from the functions they perform . . . [and that] ‘detent’ (or its equivalent ‘detent mechanism’) is just such a term”). In other words, so long as a recitation is readily understood by those in the pertinent art (*i.e.*, it is not vague and unduly broad), it must be given patentable weight.

As discussed above, the recitation “wall mountable” is a term that would be readily understood and appreciated by one of ordinary skill in the art of computers. For the reasons set forth above, the recitation “wall mountable” must be given patentable weight.

Issue No. 4

In the Final Office Action, the Examiner rejected dependent claims 19, 33, and 43 under 35 U.S.C. § 103(a) as obvious in view of the Wehr reference and in further view of the Lochridge and Goodrich references. Appellant traverses these rejections and requests that the Board withdraw the outstanding rejections in view of the following remarks. In summary, Appellant respectfully asserts that the Examiner has failed to present a *prima facie* case of obviousness regarding the instant claims, because the cited references lack the necessary motivation or suggestion for the Examiner’s proposed modification to reach the instant claims.

As discussed above, the Goodrich reference teaches against the Examiner’s proposed modification. In summary, the Goodrich reference teaches a *portable* notebook computer, which is antithetical to a wall-mounted device. Moreover, the Lochridge reference fails to obviate the deficiencies of the primary references, the Wehr and Goodrich references, as discussed above. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom

is also nonobvious. *See In re Fine*, 5 U.S.P.Q.2d at 1596. Accordingly, Appellant respectfully asserts that the Examiner has failed to present a *prima facie* case of obviousness regarding the instant claims.

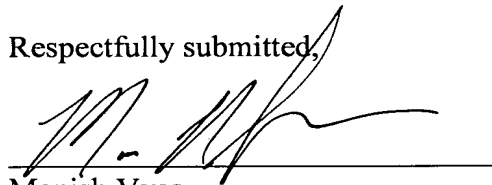
Therefore, Appellant respectfully asserts that dependent claims 19, 33, and 43 are patentable not only for their dependencies on allowable base claims, but also for the additional features recited therein. Respectfully, Appellant requests that the Board withdraw any outstanding rejections in relation to the instant claims.

CONCLUSION

In view of the foregoing remarks, Appellant respectfully requests the Board withdraw any outstanding rejections in relation to the instant claims.

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Respectfully submitted,



Manish Vyas
Reg. No. 54,516
(281) 970-4545

CORRESPONDENCE ADDRESS
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

9. APPENDIX OF CLAIMS ON APPEAL

1. (previously presented): A space saving system, comprising:
a personal computer including a housing configured for a display, the housing having a plurality of computing components disposed therein; and
a wall mount structure configured to mount the housing on a substantially vertical surface.
2. (original): The system of claim 1, wherein the housing has a slim thickness.
3. (previously presented): The system of claim 1, wherein the housing comprises a substantially flat panel.
4. (original): The system of claim 1, wherein the housing comprises a plurality of modular bays configured for supporting at least a portion of the computing components.
5. (original): The system of claim 4, wherein the plurality of modular bays comprises a slot for a compact computer component.
6. (original): The system of claim 4, wherein the plurality of modular bays comprises a receptacle for a portable computer component.
7. (original): The system of claim 4, wherein the plurality of modular bays comprises a bay for a desktop computer component.
8. (original): The system of claim 1, comprising the display disposed on a face of the housing.
9. (original): The system of claim 8, wherein the display comprises a substantially flat display screen.

10. (original): The system of claim 8, wherein the display comprises a viewable area configured for a personal computer system.

11. (original): The system of claim 8, comprising display angle adjustment assembly coupled to the housing for orienting the display in a desired viewing angle.

12. (original): The system of claim 1, comprising at least one of the plurality of computing components.

13. (original): The system of claim 12, wherein the computing components comprise a processor.

14. (original): The system of claim 12, wherein the computing components comprise a motherboard.

15. (original): The system of claim 12, wherein the computing components comprise a data storage device.

16. (original): The system of claim 12, wherein the computing components comprise a battery for providing a mobile power supply.

17. (original): The system of claim 12, wherein the computing components comprise a port configured for communication with an external electronic device.

18. (original): The system of claim 12, wherein the computing components comprise a wireless communication assembly for interacting with peripheral devices.

19. (previously presented): The system of claim 1, wherein the wall mount structure comprises a plurality of keyhole slots.

20. (previously presented): The system of claim 1, comprising a horizontal mount structure configured for mounting the housing on a substantially horizontal surface.

21. (previously presented): A computing apparatus, comprising:
a personal computer, comprising:
a housing comprising a display, a plurality of computing devices and an upright surface mount configured to mount the housing to a substantially upright surface.
22. (original): The system of claim 21, wherein the display comprises a flat panel display screen.
23. (original): The system of claim 21, wherein the display comprises a viewable area adapted for a computer system.
24. (original): The system of claim 21, wherein the computing devices comprise modular bodies adapted for removable insertion into, and coupling with, the housing.
25. (original): The system of claim 21, wherein the computing devices comprise portable computer devices.
26. (original): The system of claim 21, wherein the computing devices comprise desktop computer devices.
27. (previously presented): The system of claim 21, wherein the computing devices comprise compact computer devices.
28. (original): The system of claim 21, wherein the computing devices comprise a processor unit.
29. (original): The system of claim 21, wherein the computing devices comprise a mobile power supply.
30. (original): The system of claim 21, wherein the computing devices comprise software.

31. (original): The system of claim 21, wherein the computing devices comprise a data transfer port for communicating with external devices.

32. (original): The system of claim 21, wherein the computing devices comprise a wireless communication port.

33. (previously presented): The system of claim 21, wherein the upright surface mount comprises a plurality of mounting slots.

34. (previously presented): The system of claim 21, comprising a horizontal mount structure.

35. (previously presented): The system of claim 21, comprising a wall-mountable peripheral device configured for communicatively coupling to a port of the housing.

36. (previously presented): The system of claim 21, comprising a keyboard configured for communicatively coupling to a port of the housing.

37. (previously presented): A computer system, comprising:
a personal computer having a computer enclosure, comprising:
 a display screen;
 a plurality of electronics; and
 a surface mount configured to mount the computer enclosure to a wall.

38. (previously presented): The system of claim 37, wherein the display screen comprises a substantially flat panel display.

39. (original): The system of claim 37, wherein the electronic devices comprise modular bodies adapted for removable insertion into, and coupling with, the computer enclosure.

40. (original): The system of claim 37, wherein the electronic devices comprise computer components having a compact geometry.

41. (original): The system of claim 37, wherein the electronic devices comprise a desktop computer component.

42. (original): The system of claim 37, wherein the electronic devices comprise a mobile computing component.

43. (previously presented): The system of claim 37, wherein the surface mount comprises a plurality of keyhole slots.

44. (previously presented): The system of claim 37, comprising a horizontal mounting structure.

45. (previously presented): The system of claim 37, comprising a wall mountable peripheral device communicatively coupled to the plurality of electronics.

46. (previously presented): A space saving method for a computing system, comprising:
integrating a display assembly with a plurality of computing components in a panel enclosure of a personal computer; and
coupling a vertical surface mount to the panel enclosure.

47. (previously presented): The method of claim 46, wherein integrating comprises disposing a display screen of the display assembly on a face of the panel enclosure.

48. (previously presented): The method of claim 46, wherein integrating comprises integrating a central processor within the panel enclosure.

49. (previously presented): The method of claim 46, wherein coupling comprises coupling a wall mount to the panel enclosure.

50. (previously presented): The method of claim 46, comprising coupling a desk mount to the panel enclosure.